

REMARKS

Claims 1-22 are currently pending in the application. By this amendment, claims 1, 3, 17 and 20 are amended for the Examiner's consideration. Support for the amended claims is found in at least Figures 1 and 3 and the description at page 8 of the specification. No new matter is added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Applicants submit that entry of the Amendment is proper under 37 C.F.R. §1.116 since the Amendment:

- (a) places the application in better condition for allowance for the reasons discussed herein;
- (b) does not raise new issues requiring further search and/or consideration by the Examiner because these arguments were previously considered by the Examiner and thus further consideration and/or search by the Examiner is not warranted;
- (c) does not present any additional claims without canceling a corresponding number of finally rejected claims;
- (d) places the application in better form for an appeal, should an appeal be necessary; and
- (e) responds to formal matters set forth by the Examiner.

The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the Final Rejection. Accordingly, entry of the Amendment is respectfully requested.

Allowed Claims

Applicants appreciate the indication that claims 13-16 are allowed. Applicants further submit that claims 6, 7, 9, 10, 15 and 17-21 also contain allowable subject matter once the §112, 2nd paragraph rejections are overcome. Applicants base this on the fact that these claims are

not rejected based on any prior art references. To this end, Applicants submit that the §§112, 2nd paragraph rejection is overcome in view of the below remarks, and accordingly claims 6, 7, 9, 10-12, 15 and 17-21 should now be in allowable form.

Applicants also respectfully submit that remaining claims are allowable in view of the above amendments and the following remarks.

§112, 2nd Paragraph Rejection

Claims 1-10 and 17-20 were rejected under 35 U.S.C. §112, 2nd paragraph. This rejection is traversed.

Applicants have amended claim 1 to recite the use of a means for detecting edges. This detecting means may be, for example, an optical recognition system or any equivalent system known to be capable of detecting bound and non bound edges of a product. In fact, this detecting means can be a counter or even human intervention. Applicants have also amended claim 17 to include bound and non-bound edges. Claim 20 is also amended in accordance with the amendment to claim 17. Applicants submit that these amendments are made strictly for clarity purposes and not for reasons of patentability.

Applicants disagree with the Examiner's remarks concerning claims 1-10 and 17-20; that is, Applicants submit that these claims do not omit essential elements. In particular, the Examiner is of the opinion that the use of an "optical edge recognition system", and the phrase "bound" edges are essential to the practice of the invention and that these steps are omitted from the claimed inventions. Applicants disagree.

As previously submitted and attested to in the affidavit under 37 C.F.R. §1.132 of expert, Mr. Michael Wisniewski, the optical character recognition system (albeit novel in combination with other features) is not required by the claimed invention to work in its intended manner. Applicants submit that this feature is not adding new matter. In fact, Applicants submit that the affidavit shows that one of ordinary skill in the art, without modification or varying from the intended scope of the claims, can practice the invention without the use of an optical system, albeit an optical system can work well. As discussed previously, the system and method may work using, for example, a known count of the product stacked in a certain orientation.

Applicants also submit that this system and method can work with the use of an operator determining the orientation of the edges. Accordingly, the use of an optical system is not essential to the practicing of the invention.

The Examiner is also of the opinion that the detecting step of claim 20 is indefinite based on the phrase “a difference in thickness between the edges”. Applicants again reiterate that this claim language is definite. Claim 20 is amended to recite that there is a comparison between edges of the same product. Additionally, claim 20 recites the use of bound and non bound edges, in context of the claim.

Accordingly, Applicants respectfully request that the rejection over claims 1-10, 15 and 17-20 be withdrawn.

§102(b) Rejection

Claims 1-5, 8, 11, 12 and 22 were rejected under 35 U.S.C. §102(b) over Borchert et al. This rejection is respectfully traversed.

Applicants submit that the Borchert reference does not show all of the features of the claimed invention. For example, the Borchert reference does not show a means for detecting an edge (e.g., bound and non bound edge) of a product and moving the product in order to form a homogenous stack. That is, Borchert does not show a means for detecting a bound or non bound edge. This language, in means-plus-function format, should be given patentable weight.

Additionally, the Borchert reference does not show, for example,

... the feed head mechanism allows arrangement of products transported to the remaining compartments to be each stacked proximate the moveable plates and oriented with bound edges in the homogenous orientation according to an output of the detecting means.

Borchert, in contrast, is directed to moving interleaving papers away from printed papers during a printing process. Borchert shows the use of scanners used to distinguish between an interleave sheet and a printed sheet by brightness. For example, col. 1 discloses

... this object may be realized in that the pneumatic lifting devices are associated with light sources and photoelectric cells which control the operation of the sheet lifting device as a function of the differential brightness values of the [printed and non printed] sheet surfaces.

These scanners are not designed nor is there any disclosure to use these scanners for detecting a bound and non bound edge of the product. In fact, such a feature would not even be contemplated in Borchert since it is directed to separating individual interleave sheets from printed sheets (where the entire device is premised on the need to have interleave sheets so that ink will not transfer between the printed sheets). There is no bound product being used in the Borchert apparatus. Accordingly, Borchert is not concerned with edge detection systems; rather, Borchert uses differential light to detect differences in printed and non printed sheets of paper.

Applicants also are of the opinion that the use of the invention for orientating the product in a homogenous manner would be a feature that should be considered in the examination of these claims, despite the Examiner's argument to the contrary. This feature is not an intended use since it is not an optional use, in accordance with MPEP §2106, as provided, in part, below.

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Additionally, Applicants submit that the Examiner should consider each and every feature of the claimed invention in accordance with MPEP §2106. By way of illustration, MPEP §2106 states:

When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the

analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.").

Thus, this feature should be given patentable weight. To this end, and as discussed above, the Borchert reference does not show stacking the product into a homogenous orientation. Instead, Borchert is directed to sorting interleaved and printed paper from one another.

As to the dependent claims, Applicants submit that Borchert does not show moveable walls separating each of the plurality of compartments. The walls of Borchert are stationary. The walls, referred to by the Examiner, are not the walls which separate compartments. These walls are part of the stack elevator. Additionally, Applicants maintain the Borchert does not show different compartments. The side portions of the Borchert apparatus are simply holders, and not compartments as used by the invention.

Accordingly, Applicants respectfully request that the rejection over claims 1-5, 8, 11 and 12 be withdrawn.

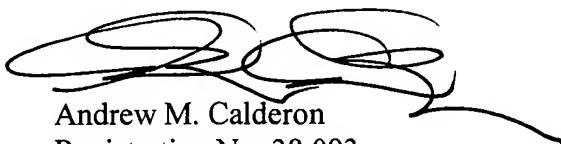
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CONCLUSION

In view of the foregoing amendments and remarks, Applicants submits that all of the rejections are overcome. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Respectfully submitted,



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